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In re Application of :
GAJEW CZYK, Diana M. et al :
U.S. Application No.: 09/786,235 :
PCT No.: PCT/CA00/00807 :
Int. Filing Date: 03 September 1999 :
Priority Date: 04 September 1998 :
Attorney Docket No.: 1038-1129 MIS:jb :
For: TREATMENT OF CERVICAL CANCER :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.137(b) filed 03 April 2003.

BACKGROUND

On 04 February 2003, a decision notifying applicants that the above-captioned application was abandoned for failing to timely respond to the Form PCT/DO/EO/916 mailed 20 February 2002 was sent. Applicants were given two months to respond.

On 03 April 2003, applicants submitted the instant petition to revive. Applicants previously submitted a petition under 37 CFR 1.47(a) on 07 May 2002 and an updated petition on 29 July 2002. The petition filed 29 June 2002 was accompanied by, *inter alia*, a 'Declaration Under 37 CFR 1.47(a)' ('Decl.') signed by Michael I. Stewart.

DISCUSSION

Petition to Revive

Applicants' "Petition to Revive an Unintentionally Abandoned Application Under 37 CFR 1.137(b)" filed on 03 April 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicants submitted a petition under 37 CFR 1.47(a) on 07 May 2002 in response to the Form PCT/DO/EO/916 mailed 20 February 2002. This is considered an appropriate response despite being untimely and the merits of the petition under 37 CFR 1.47(a) will be discussed below.

The petition to revive fee of \$1,300.00 has been paid. Applicants state that "[t]he entire delay in filing the required reply until the filing of this petition under 37 CFR

1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required.

Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the \$130.00 petition fee has paid.

Regarding item (3), applicants state that the last known address of the nonsigning inventor is:

Diane M. Gajewczyk
21 Crafton Avenue
Toronto, Ontario
Canada M6R 1C3

This information satisfies item (3).

With regards to item (2) of 37 CFR 1.47(a), counsel states that a complete copy of the specification including claims was sent to the nonsigning co-inventor on 12 September 2001, but "[t]o date, Diane M. Gajewczyk has not contacted the Patent Department of Aventis Pasteur Limited and the executed Declaration and Power of Attorney has not been returned." Decl. at # 6.

This is not sufficient to meet the requirements of item (2). Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) explains what is required to prove a refusal by an inventor and states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts

upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

In this petition, applicants have not provided any documentary evidence to support the facts alleged in the petition. For example, there is no evidence that a complete copy of the application was received by the nonsigning co-inventor. As stated in section 409.03(d) of the MPEP below, this detail is critical in satisfying a petition alleging a refusal by a co-inventor to sign. The pertinent section states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration . . .

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

Since applicants have not provided the requisite documentary evidence to meet the requirement noted above, item (2) is not satisfied.

With regards to item (4), applicants submitted a declaration signed by seven of the eight listed co-inventors. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. This declaration would have been in compliance with 37 CFR 1.497(a) and (b) and satisfied the requirements of section 409.03(a) of the MPEP.

However, the declaration does not meet the requirements of 37 CFR 1.497

because applicants submitted one complete declaration and a portion of another declaration to meet this requirement. The declaration submitted on 20 March 2002 for the nonsigning co-inventor contains only one pages 1, 2, 3 and 4, but two page 5's. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration, it is not clear what inventive entity was listed on the declaration signed by each co-inventor. Applicants must submit the complete declaration signed by each co-inventor.

For this reason, item (4) is also not satisfied.

Therefore, applicants have not met all of the requirements of 37 CFR 1.47(a).

CONCLUSION

Accordingly, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Applicants are advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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